

if the first personal store payee name is not the same as the preferred payee name, then responding to the link between the first personal store payee name and the preferred payee name by displaying the preferred payee name in the place of the first personal store payee name within the payee field; and

if the first personal store payee name is the same as the preferred payee name, then eliminating the link between the first personal store payee name and the preferred payee name, eliminating the preferred payee name, and displaying the first personal store payee name within the payee field.

### **REMARKS**

The applicants and the undersigned thank Examiner Marsh for his careful review of this patent application. Reconsideration of the present application is respectfully requested in view of the foregoing amendment and the following remarks, which are responses to the Office Action mailed May 25, 1999. In the Office Action, the Examiner rejected Claims 1-20 and 22-25. Upon entry of this amendment, Claims 1-20 and 22-25 remain pending in the present application.

The Applicants also thank Examiner Caudle for her time and consideration given during the telephone interview conducted on August 2, 1999. The Applicants have summarized some of the key points addressed during the interview in the interview summary section below.

#### **Interview Summary Pursuant to MPEP § 713.04, 12th Paragraph**

Pursuant to M.P.E.P. § 713.04, twelfth paragraph, the Applicants respectfully request the Examiner to review and to determine the accuracy of the following interview summary for the telephonic interview conducted between the Examiner and the Applicants' representative on August 2, 1999. The Applicants thank the Examiner for her time and consideration given during this telephonic interview.

During the interview, the Examiner initially focused on independent claims 11, 16, and 20, which were not amended according to the Applicants' proposed amendment that was sent

to SPE Allen MacDonald on July 22, 1999. These independent claims are drawn to the method and system for the automated balance adjustment (ABA) feature of the invention.

The Examiner indicated that the term "opening balance" in the preamble of these claims was unclear. The Examiner questioned if this term meant only the value of the personal data store at the initial setup of the personal data store or if the term meant a value of the personal data store that is updated during each reconciliation with the on-line financial statement.

The Applicants respectfully submit that the specification does state that the process of updating the "opening balance" is automatically performed each time the user chooses an option to download data from an on-line banking service into the personal data store. See page 27, lines 15-21. The Applicants have amended claims 11, 16, and 20 in accordance with the Examiner's helpful comments.

During the interview, the Applicants informed Examiner Caudle that the proposed amendment did not address independent claims 11, 16, and 20 (these claims were not amended to overcome the prior art) because the Simmons patent is drawn to a bank host driven system as opposed to a system having a personal data store that is manipulated by a user. Examiner Caudle stated that while the Simmons patent may not address this environment of downloading data from an on-line service, it was her opinion that conventional software such as "Quicken" may carry out such steps as set forth in independent claims 11, 16, and 20.

The Applicants stated that conventional art such as "Quicken" has not been used in any Office Action to date. Examiner Caudle then indicated that she would research the prior art and employ prior art in her next action that addresses the Applicants' claimed method steps. The Applicants then asked Examiner Caudle for her opinion of proposed amended independent claims 1, 4, 8, 10, and 22.

After the Applicants directed Examiner Caudle to specific parts of the Simmons patent (supporting the Applicant's position that the Simmons patent is drawn to a bank host driven system as evidenced by column 10, lines 4-22 and column 12, lines 36-51), she stated that the

limitations may overcome the Simmons patent. However, she stated other prior art may exist that reads on claims 1, 4, 8, 10, and 22.

The Applicants respectfully stated that the Office Actions to date have not provided prior art demonstrating the method steps as outlined in claims 1, 4, 8, 10, and 22. Examiner Caudle indicated that the proposed amendment probably overcomes the Simmons patent, but the Examiner again indicated that she is confident that other prior art exists that reads on these claims. The Applicants requested the Examiner to use such prior art in the next Office Action if such prior art exists.

The Applicants respectfully submit that the above interview summary is complete and an accurate account of the teleconference conducted on August 2, 1999. Consideration and approval of this interview summary are respectfully requested.

**Rejection Under 35 U.S.C. § 112, Second Paragraph**

Claims 1-10 and 22-25 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicants regard as the invention. This rejection is respectfully traversed.

Specifically, regarding Claim 1, the Examiner states that it is unclear how, if the first field parameter has already been changed to a second field parameter, a link can be created between the first field parameter and the second field parameter, responsive to an indication that this change has already taken place. The Examiner has similarly rejected Claims 4, 8, 10 and 22 according to this logic. In order to overcome this rejection, the applicants have amended the claims in accordance with the Examiner's very helpful and thorough comments. Accordingly, reconsideration and withdrawal of this rejection are respectfully requested.

**Rejections Under 35 U.S.C. §§102 and 103**

Claims 1, 11, 14-20, and 22-24 stand rejected under 35 U.S.C. §102(b) as being anticipated by Simmons (U.S. Patent No. 5,093,787). Claims 2-10, 12-13, and 25 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Simmons. The applicants respectfully offer remarks to traverse these pending rejections.

**Claims 1, 4, 8 and 10**

The rejections of Claims 1, 4, 8, and 10 are respectfully traversed. It is respectfully submitted that the Simmons patent fails to describe, teach, or suggest the recitations enumerated in amended Claims 1, 4, 8, and 10. Specifically, the Simmons patent fails to teach, suggest, or describe the combination of method steps relating to changing a first field parameter to a second field parameter generated by a user, where the second field parameter is a user-preferred substitute for the first field parameter. Further, the Simmons patent fails to show a combination of method steps relating to creating a link between a first field parameter and a second field parameter or a third field parameter, as recited by amended claims 1, 4, 8, and 10.

**The Simmons Patent is Drawn to a Host-Driven Check Balancing System**

The applicants respectfully submit that the Simmons patent is substantially drawn to a bank host that communicates with a personal electronic check register (ECR). The bank host focuses on the ECR's date and time clock in order to identify and synchronize subsequent transactions. The ECR is designed to upload check transaction data to a bank host (the ABC system). See column 10, lines 4-22 of the Simmons patent. The bank host manipulates this check transaction data received from the ECR and compares this data to data received from the banks' system. The bank host then forwards the manipulated data (in the form of a reconciled or balanced statement) to the ECR where the ECR replaces its memory contents with the data received from the bank host. See column 12, lines 36-51. See column 6, line 31-37, which describe the date and time focus of the ECR for the tagging of ATM transactions and deposits.

The Simmons patent explains that the bank host automatically ascertains if an ECR's transactions have become out-of-sync with the bank's records. This out-of-sync error is sensed by scanning comparative identical error offsets. When an out-of-sync error is identified by the host, the host creates an error message for display on the printed statement. The host also generates a message for the user giving him the option of striking a single key on the ECR and having all the erroneous transactions with mismatched transaction numbers corrected automatically and restored in his ECR. In the alternative to automatically correcting the mismatched transaction numbers, the user may choose to scan and edit the transactions manually with the ECR. However, when the user chooses auto correction, the bank host sends revised check images to the ECR, where they are accepted at face value and replace the old records. See column 12, lines 36-51.

While the Simmons patent does state that a user can choose to scan and edit transactions manually on his ECR, the Simmons patent does not provide any teaching of a method where a first field parameter is changed to a second field parameter generated by a user, where the second field parameter is a user-preferred substitute for the first field parameter. One of ordinary skill in the art recognizes that the Simmons patent is drawn to an automated, host-driven, on-line system that receives check transaction data from the ECR. This check transaction data of the Simmons patent is manipulated without significant user intervention or input. Further, the Simmons patent is not concerned with creating a link between a first field parameter and a second field parameter since the Simmons patent is substantially drawn to dates and times of transactions as evidenced by column 6, lines 55-65. The Simmons patent explains that capturing transactions with time/date data allows the host logic at a bank to minimize user intervention by automatically matching its own bank day records with the data generated an ECR.

Diametrically opposite to the Simmons patent, the present application permits a user to generate second or third field parameters that are used as substitutes for a first field parameter. Such a method of changing a first field parameter to a second or third field parameter, provides for a system where check transaction data is more readily identifiable by a user as opposed to relying on date and time stamps of each individual transaction.

The Simmons Patent Does Not Provide Any Teaching of Data Links

The Examiner admits that the Simmons patent does not provide any teaching of creating and using links between first and second or third field parameters. In order to make up for the “link deficiency” of the Simmons patent, the Examiner takes “Official Notice” of such links and states that the incorporation of multiple field parameters using links is common practice in the art of spreadsheets. The Examiner states that links are present in spreadsheets where new field parameters are used in place of old field parameters for which the new field parameters have been substituted, whether it be in display or in calculation.

In response to the “Official Notice” position taken by the Examiner with respect to making and using links between first and second or third field parameters, the applicants seasonably traverse this well-known statement and request evidence of how and why one of ordinary skill in the art would employ links in the Simmons patent. If the Examiner does not provide evidence for his well-known statement, then the applicants respectfully call for an affidavit from the Examiner.

The applicants respectfully remind the Examiner that MPEP §2144.03 third and sixth paragraphs (7<sup>th</sup> Edition, July 1998), state the following:

“When a rejection is based on the facts within the personal knowledge of the Examiner, the data should be stated as specifically as possible, and the facts must be supported, when called for by the applicant, by an affidavit from the Examiner. Such an affidavit is subject to contradiction or explanation by the affidavits of the applicant and other persons. See 37 C.F.R. §1.104(d) (2)...”

“If applicant does not seasonably traverse the well-known statement during examination, then the object of the well-known statement is taken to be admitted prior art. In re Chevenard, 139 F.2d 71, 60 USPQ 239 (CCPA 1943). A seasonable challenge constitutes a demand for evidence made as

soon as practicable during prosecution. Thus, applicant is charged with rebutting the well-known statement in the next reply after the Office Action in which the well-known statement was made. This necessary because the Examiner must be given the opportunity to provide evidence in the next Office Action or explain why no evidence is required.”

The applicants respectfully submit that the Simmons patent does not provide any teaching of a combination of steps that permit change of a first field parameter to a second field parameter or a third field parameter generated by a user where the second field parameter or third field parameter is a user-preferred substitute for the first field parameter, as recited in amended claims 1, 4, 8, and 10. Further, the Simmons patent does not provide any teaching of creating a link between a first field parameter and a second or a third field parameter. As mentioned above, the Simmons patent is substantially drawn to an automated check transaction reconciling system where transaction times and dates are compared and manipulated on a bank host side.

Since the Simmons patent employs a bank host to manipulate check transaction data, the applicants respectfully submit that it would be counter-intuitive and contradictory to the teachings of Simmons to permit a user to substitute a second field parameter for a first field parameter. Creating links between field parameters of the Simmons patent having date and time stamps would also not make sense since the host of the Simmons patent matches transactions according to the date and time stamps and not field parameters such as payee names.

Therefore, the Simmons patent cannot anticipate nor render obvious limitations drawn to changing a first field parameter to a second field parameter generated by a user, where the second field parameter is a user-preferred substitute for the first field parameter, as recited in amended claims 1, 4, 8, and 10. Accordingly, reconsideration and withdrawal of the rejections of Claims 1, 4, 8, and 10 are respectfully requested.

**Claim 22**

The rejection of Claim 22 is respectfully traversed. It is respectfully submitted that the Simmons patent fails to describe, teach, or suggest each recitation of Claim 22. The Simmons patent fails to provide any teaching of a combination of method steps relating to changing a first one of payee names of personal data store to a substitute payee name generated by a user and then downloading an on-line financial statement comprising original payee names from on-line banking service, and replacing each first payee name of the original payee names with the substitute payee name and displaying the substitute payee name within a payee field of a display screen. As noted above, the Simmons patent is substantially drawn to an automated system where the majority of check transaction data manipulation occurs on the host side. The Simmons patent also is drawn to a system where user intervention or manipulation of check transaction data is substantially reduced.

In light of these differences, one of ordinary skill in the art recognizes that the Simmons patent cannot anticipate nor render obvious limitations drawn to changing a first one of payee names of a personal data store to a substitute payee name generated by a user and then downloading and manipulating an on-line financial statement from an on-line banking service. Accordingly, reconsideration and withdrawal of Claim 22 are respectfully requested.

**Claims 11, 16, and 20**

The rejection of Claims 11, 16, and 20 are respectfully traversed. It is respectfully submitted that the Simmons patent fails to describe, teach, or suggest each recitation of Claims 11, 16, and 20. The Simmons patent fails to provide any teaching of method steps relating to displaying a personal data store containing an opening balance, a plurality of transactions organized by date, and ending balance; downloading an on-line financial statement containing a plurality of transactions recognized by date, and ending period and an ending balance; and if the earliest dated transaction in the personal data store is not later than the earliest dated transaction in the on-line financial statement, then determining whether any of the transactions of the on-line financial statement have been downloaded into the personal data store.

As described above with respect to Claims 1, 4, 8, and 10, the Simmons patent is substantially drawn to a system where check transaction data is only manipulated on the bank host side. The Simmons patent explains that the ECR sends to the host all of its check transaction data including times and dates as evidenced by column 10, lines 7-21.

The Simmons patent also explains that the electronic check register (ECR) accepts new, voided, and replacement transactions. The ECR of the Simmons patent remaps memory to accommodate new transactions that require additional memory followed by acknowledgement to the host of the receipt of such data. To begin statement reprinting with a clean slate and to verify that changes were received and stored intact, the ECR of the Simmons patent sends to the host all of its memory parameters such as time matched transactions, adjustments, and voided transactions not previously sent to the bank host. The Simmons patent further describes how the auto balancing session is conducted by the bank host. See column 15, lines 9-32.

In light of these teachings, one of ordinary skill in the art recognizes that the Simmons patent cannot anticipate nor render obvious limitations drawn to a combination of method steps that download an on-line financial statement where the data in such a statement is manipulated if the earliest dated transaction in a personal data store is not later than the earliest dated transaction in the on-line financial statement. The Simmons patent and the present application are simply diametrically opposite to one another: the Simmons patent requires data manipulation by the host side whereas the present application includes data manipulation on a non-host side. Accordingly, reconsideration and withdrawal of the rejections of Claims 11, 16, and 20 are respectfully requested.

**Claims 2, 3, 5-7, 9, 12-15, 17-19, and 23-25** \_\_

The applicants respectfully submit that the above-identified dependent claims are allowable because the independent claims from which they depend are patentable over the cited references. The applicant also respectfully submits that the recitations of these dependent claims

are of patentable significance. Accordingly, the applicants respectfully traverse the rejections of dependent claims 2, 3, 5-7, 9, 12-15, 17-19, and 23-25.

In view of the foregoing, the applicant respectfully requests the Examiner to withdraw the pending rejections of claims 2, 3, 5-7, 9, 12-15, 17-19, and 23-25.

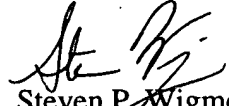
### CONCLUSION

The amendments to claims 11, 16, and 20 have been made solely for the purpose of clarifying the claimed language in accordance with the interview conducted with the Examiner on August 2, 1999.

The foregoing is submitted as a full and complete response to the Office Action mailed May 25, 1999 the applicants and the undersigned thank Examiner Marsh for his consideration of these remarks. The applicants have amended the claims and have submitted remarks to traverse the rejections of Claims 1-20 and 22-25. The applicants therefore respectfully submit that the present application is conditioned for allowance. Such action is hereby courteously solicited.

If the Examiner believes that there are any issues that can be resolved by telephone conference, or that there are any informalities that can be corrected by an Examiner's Amendment, please call the undersigned at (404) 949-2400.

Respectfully submitted,

By:   
Steven P. Wigmore  
Reg. No. 40,447

JONES & ASKEW, LLP  
2400 Monarch Tower  
3424 Peachtree Road, N.E.  
Atlanta, Georgia 30326  
(404) 949-2400  
Our File: 13237-1560  
MS File: 79556